GT

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,125	05/22/2001	Elizabeth S. Light	6270-709.301	9583

21971 7590 02/02/2006

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 94304-1050

EXAMINER	
SISSON, BRADLEY L	

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Examiner-Initiated Interview Summary	Application No.	Applicant(s)	
	09/863,125	LIGHT, ELIZABETH S.	
	Examiner	Art Unit	
	Bradley L. Sisson	1634	

All Participants:

(1) *Bradley L. Sisson*.

(2) *Shirley Chen, Ph.D., Esq.*.

Status of Application: *061*

(3) _____.

(4) _____.

Date of Interview: *31 January 2006*

Time: _____

Type of Interview:

☒ Telephonic

☐ Video Conference

☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

Exhibit Shown or Demonstrated: ☐ Yes ☐ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

Possible rejection of draft claims submitted 24 January 2006

Claims discussed:

27, 29, and 30

Prior art documents discussed:

See Continuation Sheet

Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet

Part III.

☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.

☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.

B. L. Sisson

(Examiner/SPE Signature)

(Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Identification of prior art discussed: Morey et al., "Non-isotopic in situ hybridisation and immunophenotyping of infected cells in the investigation of human fetal parvovirus infection," Journal of Clinical Pathology, Vol. 45, No. 8, August 1992, 673-678. Vernole, "Digoxigenin-Labeled Probes Can Detect Single-Copy Genes in Human Metaphase Chromosomes," Biotechniques, Vol. 9, No. 2, (1990), pp. 200-204..

Continuation of Substance of Interview including description of the general nature of what was discussed: Mr. Sisson directed attention to the abstract of Morey et al., which teaches that "[d]igoxigenin labelled probes gave greater specificity" and that [d]igoxigenin is a more reliable probe label than biotin for in situ hybridization." Mr. Sisson also directed attention to page 67e, right column, which teaches that formalin-fixed, paraffin wax embedded tissue samples were analyzed. Mr. Sisson asserted that given these teachings, one would have been highly motivated to use digoxigenin-labeled probes in an in situ hybridization assay. In response to comment by Dr. Chen that Morey et al., does not teach detecting single copy DNA sequences, Mr. Sisson noted that Vernole teaches explicitly of detecting single-copy genes via in situ hybridization where the probe was labeled with digoxigenin, and hybridization products were detected using anti-digoxigenin antibodies that were labeled with alkaline phosphatase. In response to assertions by Dr. Chen that the claim is limited to detecting single copy genes, and that one is to assay a tissue sample, that there is no suggestion of being able to detect single copy gene in tissue when the prior art teaches detecting single genes in a cell suspension, Mr. Sisson noted that the application as filed places no distinction between being able to detect single copy sequences in a cell or tissue sample. Mr. Sisson also noted that there is no evidence of record that would lead one to believe that digoxigenin-labeled probes would not be able to detect single copy sequences when the art teaches that such has been achieved. Mr. Sisson noted that the claims and the specification place no specific requirements on the probe sequence being used, and as such, the claimed method fairly encompasses using the same probes and conditions recited in the prior art, and given that a product and its properties are inseparable, one would reasonably believe that these same conditions and reagents would work in the claimed method.

Mr. Sisson also directed attention to page 11, third paragraph, of the specification which teaches, "the cell must be adequately digested to permit the reagents to associate at the location of the chromosome," yet the claims do not recite this requirement. Mr. Sisson indicated that possible scope of enablement issue may exist in this regard as the claims as presently worded, do not require any enzymatic digestion in order for the assay to be conducted.